

REMARKS

Claims 1, 5, 8, 9, 12, 13 and 17-19 are pending in this application. Of these pending claims, Claims 1, 5, 8, 9, 12, 13 and 17-19 stand rejected. By way of this paper, Claim 1 has been amended.

The foregoing amendments and following remarks are believed to be fully responsive to the outstanding office action, and are believed to place the application in condition for allowance.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 1, 5, 8, 9, 12, 13, and 17-19 stand rejected under 35 U.S.C. §112, second paragraph, as failing to comply with the written description requirement. By way of this paper, Claim 1 has been amended the claim to remove the phrase “adapted to” to point out particularly and claim distinctly the subject matter that Applicants regard as the invention so as to overcome the rejection under 35 U.S.C. §112, first paragraph. Applicant believes no new matter has been added with these amendments.

Claims 5, 8, 9, 12, 13, and 17-19 depend either directly or indirectly from independent Claim 1. As such, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 5, 9, 12, 13 and 17-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the *Botros* (6,280,512) reference in view of the *Moffatt* (6,323,257) reference. Currently pending Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Botros* in view of *Moffatt* et al. as applied to claims 1, 5, 9, 12-13, and 17-18 above, and further in view of *Kashiwazaki* ('098). Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the *Botros* in view of *Moffatt* as applied to claims 1, 5, 9, 12-13, and 17-18 above, and further in view of *Hayes* ('997).

Regarding Claim 1, Applicant respectfully submits that *Botros* was filed on July, 28, 1999, and issued on August 28, 2001, while the pending application was filed June 27, 2001. Additionally, *Botros* and the pending application have distinct inventive entities. As such, *Botros* is available as prior art under 35 U.S.C. §102(e). Applicant also states that the subject matter of

Botros and the invention claimed in the pending application were, at the time the invention was made, owned by Scitex Digital Printing, Inc. or subject to an obligation of assignment to Scitex Digital Printing, Inc. Accordingly, Applicant requests that *Botros* be removed from consideration by the Examiner under 35 U.S.C. §103(c) to the extent that *Botros* is used in the 35 U.S.C. 103(a) rejection of Claim 1 described above.

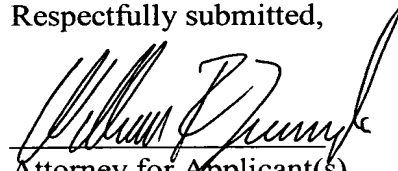
Claims 5, 8, 9, 12, 13 and 17-19 are dependent on independent Claim 1, and therefore include all the features thereof. For the reasons set forth above with regard to the independent claim, Claims 5, 8, 9, 12, 13 and 17-19 are also believed to be patentable. As such, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims.

CONCLUSION

It is respectfully submitted that, in view of the above amendments and remarks, this application is now in condition for allowance, prompt notice of which is earnestly solicited.

The Examiner is invited to call the undersigned in the event that a phone interview will expedite prosecution of this application towards allowance.

Respectfully submitted,



Attorney for Applicant(s)
Registration No. 45,287

William R. Zimmerli/tt
Rochester, NY 14650
Telephone: (585) 588-2758
Facsimile: (585) 477-1148